

**REMARKS**

Claims 1-6, 9-14, and 17-26 are pending and stand rejected. Claims 7, 8, 15, and 6 have been cancelled. Claims 17, 22, and 25 have been amended to correct minor errors.

The Examiner rejected Claims 1-3 and 9-12 under §102 as being anticipated by a Forbes Magazine Article. For the stated purpose of showing "the inherent features of the claims," the Examiner supported that rejection by citing an additional nine non patent references. With limited exceptions enumerated in MPEP 2131.04, a §102 rejection of a claim is only proper when each and every element as set forth in the claim is found, expressly or inherently, in a *single* prior art reference. The Examiner's stated purpose does not fall within any exception.

The test for whether a §102 rejection is proper is whether the cited reference teaches the combination or elements required by a claim. The test does not involve a determination of whether the cited reference teaches an inherent feature or features of a claim. Any reliance by the Examiner on the additional nine references was improper in making the rejection under §102. Moreover, the Forbes Article relied on by the Examiner does not provide an enabled disclosure. For at least these reasons, the rejection of Claims 1-3 and 9-12 under §102 was improper.

The Examiner rejected Claims 4-8 and 13-26 under §103. In doing so, the Examiner failed to designate primary reference and failed to express any motivation found in the references to modify the primary reference (which ever it may be) to achieve that which is required by the rejected Claims. Consequently, the Examiner has failed to establish a *prima facia* case for obviousness with respect to the rejections of Claim 4-8 and 13-26.

**REJECTIONS UNDER 35 U.S.C. §112**

The Examiner rejected Claims 1-6, 9-14, 17-24, and 25-26 under 35 USC §112 second paragraph. The Examiner asserts that these claims include the terms "positioning service" and "position locator" and that "these terms are not defined in the specification." The Applicants disagree and ask the Examiner to reread paragraph [0017] of the specification.

**REJECTIONS UNDER 35 U.S.C. §102**

The Examiner rejected Claims 1-3 and 9-11 as being anticipated by an article in Forbes Magazine written by Kelly Barron and published on January 10, 2000 (Referred to as Barron). In support of the §102 rejection, the Examiner also cites the following non-patent publications:

1. <http://web.archive.org/web20000304084927/http://www.ups.com/>, archived March 4, 2000, printed January 12, 2004, pg. 1 (Home Page);
2. Delivery Confirmation/Proof of Delivery (P.O.D.) Page of UPS, <http://web.archive.org/web20000229123602/http://www.ups.com/using/services/aees/deleonfguide.html>, archived February 29, 2000, printed January 12, 2004, pp. 1-2 (Delivery Confirmation);
3. Globetrotter, Electronics Times, July 27, 1998, pg. H1 (Electronic Times);
4. Ditter, UPS, Truly a Business of Sorts; an Accurate and Speedy Sorting and Delivery System is Vital for Survival in the Next-Day Express Business (United parcel Service),
5. Air Cargo World, vol. 83, no.2, February 1993, pg. 38 (Ditter);
6. ROK's Yonap: Samsung Elecro-Mech., UPS Agree to Integrate Service System, World News Connection, November, 16, 2000 (World News);
7. USPN 6,635,551 issued to Barta (Barta);
8. UPS MaxiTrac Manual, Chapters, 2-6, 8-9, May 1994 (MaxiTrac);
9. About UPS, <http://www.ups.com/content/us/en/about/lifistor/1999.html>, printed January 12, 2004, pp. 1-2; The Evolution of the UPS Delivery Information Acquisition Device (DIAD) [http://www.press-room.ups.com/mediakits/popups/factsheet/0,1889,843,00.html?ct=-factsheets&\\_at=....](http://www.press-room.ups.com/mediakits/popups/factsheet/0,1889,843,00.html?ct=-factsheets&_at=....), printed January 12, 2004, 00. 1-2.

A §102 rejection of a claim is only proper when each and every element as set forth in the claim is found, expressly or inherently, in a *single* prior art reference. The prior art reference must also supply an enabling disclosure. A §102 rejection over multiple references has been found proper only where the extra reference or references are used to (1) prove the primary reference contain an enabled disclosure; (2) explain the meaning of a term used in the primary reference; or (3)

show that a characteristic not disclosed in the primary reference is inherent. MPEP 2131.01

The Examiner stated that the additional nine references above "are utilized to show the inherent features of the claims." This is an improper use under §102 for the extra references. In the present context, the extra references have no relevance to the inherent features of the claims of the present application. Reliance on any one of the additional references in support of the §102 for the Examiner's stated reason was therefore improper.

Barron is an article discussing various technological improvements made by UPS (United Parcel Service) following a 1997 drivers strike. As will be made clear, Barron does not teach the combination of elements and limitations required by Claims 1-3 and 9-11.

Claim 1 is directed to a method for delivering goods and includes the following combination of elements and limitations:

1. transporting the goods to a specified location;
2. upon delivery, acquiring, from a positioning service, a physical location of the goods; and
3. recording the physical location to verify that the goods have in fact been delivered to the specified location.

Rejecting Claim 1, the Examiner relies on the following passages from Barrow.

1. "Since UPS began shuttling parcels from Seattle department stores with a Model T Ford and a few motorcycles in the early 1900s; it has become an almost invisible hand in the U.S. economy (see chart). Gifts from grandma, sure, but today UPS is more about serving the small-lot shipping needs of a nation flowering with eat-and-sleep entrepreneurs."
2. "UPS used to be a trucking company with technology. Now it's a technology company with trucks."
3. "A big part of the new arithmetic is the huge technology commitment. UPS can electronically track those 13 million daily packages. What's that do for the shipper? Consider the traveling salesman in Boise waiting on some samples. Through a UPS arrangement with 3COM, he can click on the UPS shield on the latest Palm VII handheld computer, enter a UPS tracking number and immediately learn the whereabouts of his goods. When it comes

time to send them off to another destination, he goes back to his Palm VII and a cellular tower detects his location and directs him to the nearest dropoff."

4. "Those seemingly untechnical UPS drivers serve as a linchpin in the company's vast electronic tracking system. They tote a computerized clipboard called a DIAD (Delivery Information Acquisition Device), which houses an internal radio that simultaneously captures and transmits delivery information. Once a customer signs on the DIAD for a package, the information is relayed through the network. The sender can go onto UPS' Web site and learn that the package has been received even before the driver has gotten back behind the wheel of his truck. Messages also can be sent to the DIAD about traffic jams on a driver's route or when a customer needs an immediate pickup. Even after decades of traveling the same streets, UPS is using global positioning satellites along with parcel-volume data to remap delivery areas."

A cursory inspection of the cited passages reveals that Barron does not teach the combination of elements and limitations of Claim 1. Moreover, the additional references do not show that an element or limitation not disclosed in the Barron is inherent to that which is disclosed by Barron. Specifically nothing in Barron teaches, upon delivery, acquiring, from a positioning service, a physical location of the goods and recording the physical location to verify that the goods have in fact been delivered to the specified location. Barrow merely mentions a device (DIAD) that simultaneously captures and transmits delivery information. Barrow describes delivery information as nothing more than the recipients signature entered through the DIAD, an indication that the package has been delivered, and perhaps information about traffic jams or a pick-up notification. The additional references do not suggest that anything more than these possible examples is inherent in the term "delivery information."

Moreover, Barrow fails to provide an enabled disclosure. Specifically, Barrow, when published, did not contain sufficient information regarding the subject matter of Claim 1 to enable one skilled in the art to make and use the claimed invention without undue experimentation. See MPEP 2164.01. Barrow provides no direction or even suggestion as to the presence or combination of all the elements of Claim 1, nor does Barrow disclose or suggest any working example of anything even resembling the claimed invention. See MPEP 2164.01(a). Barrow does not disclose or suggest the implementation of the claimed invention. See MPEP

2164.01(b) and 2164.01(c).

For at least these reasons, the Examiner's rejection of Claim 1 is improper. Claims 2 and 3 depend from Claim 1 and include all the limitations of that base Claim. For the same reasons the rejection of Claim 1 is improper, so are the rejections of Claims 2 and 3.

Claim 9 is directed to a computer program product for verifying proper delivery of goods to a specified location. The product includes a computer useable medium having machine readable instructions for:

1. reading a ticket associated with the goods, the ticket having information representing delivery data for the goods;
2. acquiring from a positioning service a physical location of the goods; and
3. recording the physical location to verify that the goods have in fact been delivered to the specified location.

The Examiner rejected Claim 9 for the same reasons as Claim 1 even though Claim 9 requires a computer useable medium having instructions for performing an act not required by Claim 1—that is – reading a ticket associated with the goods, the ticket having information representing delivery data for the goods. As such, the rejection of Claim 9 is Improper.

Moreover, Barrow simply does not teach the combination of elements of Claim 9 which not unlike Claim 1 requires that the media include instructions for acquiring from a positioning service a physical location of the goods; and recording the physical location to verify that the goods have in fact been delivered to the specified location. Thus, for the same reasons the rejection of Claim 1 is improper so is the rejection of Claim 9 and the rejections of Claims 10 and 11 which depend from Claim 9.

#### **REJECTIONS UNDER 35 U.S.C. §103**

To establish a prima facie case for obviousness under §103, the cited references must teach every element of the rejected claim and the Examiner must express some motivation to combine the references.

**Claims 6 and 12:** The Examiner rejected Claims 6 and 12 under §103 over the prior art references the Examiner cited in support of the rejection of Claims 1-3 and 9-12. Claim 6 depends from Claim 1 and includes all of its limitations. For at least the same reasons the rejection of Claim 1 is improper so is the rejection of Claim 6. Claim 12 depends from Claim 9 and includes all of its limitations. For at least the same reasons the rejection of Claim 9 is improper so is the rejection of Claim 12.

Moreover, Claims 6 and 12 add the following element "comparing the recorded location with the specified location and issuing an alert indicating discrepancies." The Examiner admits that this added element is not taught by the prior art references. Nonetheless, the Examiner concludes that:

It would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the positioning service's physical location and compared it with the location being scanned by the DIAD to check for and alert the delivery person about potential discrepancies for the explicit reasons set forth above.

The Examiner fails to point to any motivation to modify the teachings of the cited references in this manner. Moreover even if the references were so modified, it would have no bearing on Claim 6. Comparing the physical location of the positioning service with the location scanned by the DIAD has no relevance to Claim 6. While irrelevant, nothing in the cited references indicates the location of a positioning service or indicates that a DIAD scans a location. The Examiner's statement is confusing at best. The Examiner's rejections of Claims 6 and 12 are improper as the Examiner has failed to establish a *prima facia* case for obviousness..

**Claims 4-5, 7-8, and 13-26:** The Examiner rejected Claims 4-5, 7-8, and 13-26 under §103 over the prior art references the Examiner cited in support of the rejection of Claims 1-3 and 9-12 in view of USPN 5,319,374 issued to Desai and USPN 5,917,434 issued to Murphy.

Claims 4 and 5 depend from Claim 1 and include all the limitation of that base claim. For the same reasons the rejection of Claim 1 is improper, so are the rejections of Claims 4 and 5.

Claims 7 and 8 have been cancelled.

Claims 13 and 14 depend from Claim 9 and include all the limitation of that base claim. For the same reasons the rejection of Claim 9 is improper, so are the rejections of Claims 13 and 14.

Claims 15 and 16 have been cancelled.

Claim 17 is directed to a system for verifying delivery of goods to a specified location comprising:

1. a ticket delivered with the goods, the ticket containing information relating to the goods;
2. a reader operable to read the ticket upon delivery of the goods; and
3. a locator in communication with the reader, the locator operable to acquire from a positioning service a physical location of the goods as the reader reads the ticket.

Rejecting Claim 17, the Examiner cites only the same references that the Examiner relied upon to reject Claim 1. The Examiner has expressed no motivation to combine the teachings of those references. Moreover, as made clear with reference to Fig. 1, the cited references, even if combined, do not teach the combination of elements required by Claim 17. More particularly, the cited references mention nothing of a locator in communication with a reader where the locator is operable to acquire from a positioning service a physical location of the goods as the reader reads a ticket. Should the Examiner persist, the Applicants respectfully request the Examiner to specifically point to sections in the cited references that suggest a motivation that their teachings be combined. Moreover, the Applicants request that the Examiner specifically point to sections in the cited references that teach a locator in communication with the reader in the manner required by Claim 17.

For at least these reasons the Examiner has failed to establish a prima facia case for obviousness with respect to Claim 17. Claims 18-24 each depend at least

indirectly from Claim 17. For the same reasons the rejection of Claim 17 is improper, so are the rejections of Claims 18-24.

Moreover, Claim 20 depends from Claim 17 and adds an element requiring that at least some of the information contained in the ticket represent the specified location and that the system also include a comparator in communication with the reader and the position locator, the comparator operable to compare the physical location with the specified location and to issue an alert indicating discrepancies.

The Examiner rejected Claim 20 for the same reasons as Claim 6. With regard to Claim 6, the Examiner admitted that the cited references failed to teach a method step for comparing the recorded location with the specified location and issuing an alert indicating discrepancies. The Examiner failed to express any motivation found in the references to modify the references to achieve that which is required by Claim 6. Consequently, the cited references also fail to teach the added element required by Claim 20, and the Examiner has failed to express any motivation found in the references to modify the references to achieve that which is required by Claim 20. For at least these additional reasons, the Examiner has failed to establish a *prima facia* case for obviousness with respect to Claim 20.

The Examiner rejected Claims 25 and 26 citing the prior art references the Examiner cited in support of the rejection of Claims 1-3 and 9-12 in view Desai and Murphy. However, the Examiner failed to express any motivation found in the references to modify the references to achieve that which is required by Claim 25 and 26. For at least these additional reasons, the Examiner has failed to establish a *prima facia* case for obviousness with respect to Claims 25 and 26.

**CONCLUSION**

In view of the foregoing remarks, the Applicant respectfully submits that the pending claims are in condition for allowance. Consequently, early and favorable action allowing these claims and passing the application to issue is earnestly solicited. The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,  
Robert Seseck

By   
Jack H. McKinney  
Reg. No. 45,685

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